

REMARKS

This paper is filed before October 12, 2004, the shortened statutory period for reply, and does not include any additional claim. Thus, applicant respectfully submits that this paper is timely filed and no additional fees are required.

I. STATUS OF AMENDMENT

As of the Office action mailed July 12, 2004, claims 1-19 are pending and at issue in the instant application. By this amendment claims 1, 3-5, 7-11, 13, 14 and 17-19 have been amended, no claims have been canceled and no new claims have been added. Applicant asserts that no new matter has been added, and that these claims have been submitted to further claim the subject matter of applicants' invention. Thus, claims 1-19 remain pending and at issue in this application.

II. REJECTIONS UNDER 35 U.S.C. §102(b)

Applicant respectfully traverses the rejection of claims 1, 3, 7, 9-12 and 14-18 as anticipated by Guu (U.S. Patent No. 3,765,780). Amended independent claims 1, 11 and 18 recite, in relevant part, an apparatus or method including a self-contained removable auxiliary dispensing module adapted to be secured within a receptacle. The claimed auxiliary module can be inserted and removed from the receptacle formed in the writing instrument body, and can be configured to, among other things, dispense a variety of materials, such as correction tape, highlighter fluid, writing ink, etc.

Guu does not disclose a self-contained removable auxiliary dispensing module as recited by independent claims 1, 11 and 18. Guu, as illustrated in FIGS. 1-4, simply discloses a combination writing implement having a ball

point and lead cartridge secured at opposing ends of a tubular casing 10. The lead end of Guu, which is alleged to correspond to the auxiliary module specified in the claims, is not self-contained but instead includes separate, independent components that must be assembled during installation into or disassembled during removal from the writing implement. Specifically, Guu discloses a reception segment 36 threaded into the tubular casing 10 and a loose lead segment 34 secured by the reception segment 36. Removal of the reception segment 36 from the tubular casing 10 unclamps and releases the lead cartridge thereby rendering the components disassembled and unable to operate as a writing implement. Similarly, the ball point is not intended to be removed from the tubular casing, and doing so would require complete disassembly of the writing instrument. Because Guu does not disclose, or even suggest, a self-contained removable auxiliary dispensing module, the claims 1, 3, 7, 9-12 and 14-18 are not anticipated thereby.

Furthermore, because all of the claimed limitations set forth in the claims are not taught or suggested by Guu, a *prima facie* case of obviousness¹ has not been established. Thus, the claims 1, 3, 7, 9-12 and 14-18 are not rendered obvious over Guu.

¹ To establish a *prima facie* case of obviousness, three basic criteria must be met:

- (a) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (b) Second, there must be a reasonable expectation of success.
- (c) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

III. REJECTIONS UNDER 35 U.S.C. §103(a)

Applicant respectfully traverse the rejection of claims 2, 4, 5, 6, 8, 13, and 19 as obvious over Guu, in light Christopher (U.S. Patent No. 6,554,516), Holmes (U.S. Patent No. 6,461,068) or Harris (U.S. Patent No. 4,167,350).

As previously discussed in section II, independent claims 1, 11 and 18, as amended, recite an apparatus or method including a self-contained removable auxiliary dispensing module adapted to be secured within a receptacle. Guu does not teach, at any level, an auxiliary module, much less a self-contained removable auxiliary dispensing module as recited by the claims at issue.

A *prima facie* case of obviousness has not been established because none of the cited references, either alone or in combination, teaches or suggests all of the claimed limitations. In particular, none of the cited references supplies the teaching of a self-contained removable auxiliary dispensing module lacking in Guu.

Christopher teaches a writing instrument including a retractable ink cartridge and retractable correcting fluid cartridge mounted on opposite ends of the writing instrument. Neither the retractable ink cartridge nor retractable correcting fluid cartridge is a self-contained removable auxiliary dispensing module as recited by the claims, rather they are integral components of the writing instrument.

Holmes teaches a writing instrument having an inkpen top at a first end, and a correction tape dispenser at a second end. The correction tape dispenser is an integral portion of the writing instrument as illustrated in FIG.

1, and not a self-contained removable auxiliary dispensing module as recited by the claims at issue.

Harris teaches a writing instrument including a removable marking element compressively secured by a removable plug. The removable plug simply forces the removable marking element into the desired position, but does not operate, in any manner, as a self-contained auxiliary dispensing module as recited by the claims at issue. In fact, the removable plug is completely non-functional as a writing instrument much less as an auxiliary module if any kind.

Because none of the references, either alone or in combination, discloses or suggests a self-contained removable auxiliary dispensing module, these references cannot be combined or modified to establish a *prima facie* case of obviousness. For this reason, applicant respectfully submits that claims 2, 4, 5, 6, 8, 13, and 19 are not rendered obvious by any the cited references.

IV. CONCLUSION

For these foregoing reasons, applicant submits the application is in condition for allowance. If there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855 (29617/PM482). Reconsideration and withdrawal of the rejections are therefore respectfully requested.

Respectfully submitted for,

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